

Response to Office Action dated August 25, 2004  
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## **REMARKS**

Entry of the amendments is respectfully requested. Claims 1, 2, 6, 7, 10, 11, and 13 have been amended. Claims 1-16 are pending in the application. Favorable reconsideration and allowance of this application is respectfully requested in light of the foregoing amendments and the remarks that follow.

### **1. Objections to the Specification**

The disclosure is objected to because the wrong patent was referenced on page 3 of the application. The noted error has now been corrected by suitable amendment to the specification. The Examiner's diligence in noting this error is appreciated.

The Examiner also contends that on page 6, line 15 "being sandwiched" should be -- sandwiching--. The Examiner is mistaken. The phrase "being sandwiched" is grammatically correct without the context of the sentence. This objection is therefore traversed.

### **2. Claim Rejections Under 35 U.S.C. §111, ¶2**

Claims 1-16 stand rejected under 35 U.S.C. §112, ¶2, as being indefinite. The Examiner contends that the recitation of the limitation "without the use of any mounting hardware" is indefinite because one allegedly cannot determine the metes and bounds of the claim limitation. Applicant disagrees because he believes that that phrase is more than clear to one skilled in the art when read in light of the specification. Nevertheless, because the claims are allowable without the limitation in question, that limitation has

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been deleted from the claims in all occurrences in the interest of expediting prosecution.

Withdrawal of the rejection under 35 U.S.C. §112, ¶2 is therefore believed to be in order and is respectfully requested.

3. Rejections Based on the Prior Art

a. Recapitulation of the Invention<sup>1</sup>

The invention relates to a method of making lightweight, easy to assemble, and compact exciter assembly for a compaction device such as a drum assembly of a vibratory trench roller or another vibratory compactor. The exciter assembly includes a fixed weight and one or more free swinging weights that are mounted on an exciter shaft, without using any mounting hardware, so as to hold the free swinging weights axially in position while permitting them to swing between first and second angular positions on the exciter shaft. Preferably, the fixed weight is mounted on a central portion of the exciter shaft, and two free swinging weights are mounted adjacent the ends of the fixed weight so as to be restrained from substantial sliding movement along the exciter shaft solely by the fixed weight and other operative components of the exciter assembly, such as bearings and/or gears or other torque transfer elements. The lack of need for mounting hardware considerably simplifies assembly. The reduction in length afforded by this design permits a reversible hydraulic motor to be mounted coaxially on the end of the exciter shaft without unacceptably increasing the overall length of a drum assembly,

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<sup>1</sup> This Section 3a is intended to provide the Examiner with some background information on the state of the art applicants' contribution to it. It is *not* intended to distinguish specific claim for the prior art. That task is performed in Section 3b below.

thereby further simplifying the machine's assembly and facilitating maintenance or repair of the machine.

b. Rejection Under § 102(b)

i. Rejection of Claims 1, 2, 3, and 7

Claims 1, 2, 3, and 7 stand rejected under 35 U.S.C. §102(b) as being anticipated by the French '198 patent. The Examiner contends, *inter alia*, that the elements 22, 24 correspond to the claimed free swinging weights, and that the shaded, unlabeled elements between elements 14 and 22 and 16 and 24, respectively, correspond to the claimed exciter assembly components. The Examiner is mistaken.

Referring to the attached Declaration of Gregory J. Orzal, one skilled in the art understands that the structures illustrated in Figures 2 and 4 of the French '198 patent to constitute standard mounting hardware, most probably retaining rings or spacers (Orzal Decl., ¶6). In either event, they comprise standard structures mounted on the exciter shaft to prevent the free swinging weights from moving axially along the shaft. These mounting structures were in universal use at the time that the French '198 patent was filed and were still universally until the development of the invention disclosed and claimed in the present application. (Orzal Decl., ¶4) Because there is nothing in the French '198 patent to cast any doubt at Mr. Orzals' statements, the Examiner is obliged to take it at face value. *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995). Hence, those elements comprise standard mounting hardware, which the specification and Mr. Orzal's declaration confirm cannot be considered "an operative component of an

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exciter assembly.”<sup>2</sup> While the Examiner is entitled to construe claimed terms broadly, he is *not* permitted to construe a term to have a definition that is expressly disclaimed by specification and prosecution history: When the specification “makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question.” *SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, 242 F.3d 1337 (Fed. Cir. 2001).

ii. Rejection of Claims 4, 5, 8, and 9

The rejection of claims 4, 5, 8, and 9 over the French ‘198 patent in view of Century is respectfully traversed because none of the secondary references cure the above-discussed fundamental deficiency of the French ‘198 patent.

4. Allowable Subject Matter and Conclusions

The indication of the presence of allowable subject matter in claims 6 and 10-16. Claims 6 and 10 have now been rewritten in independent form to include the limitations of claims 1 and 7, respectively, thereby placing these claims in *prima facie* condition for allowance. Claim 11 has been amended in a manner that clearly obviates the rejection

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<sup>2</sup> Operative components are distinguished from mounting hardware such as retainer rings, e.g., on, page 3, lines 10-23 and page 8, lines 15-18 of the specification. The amendment to page 5 to state that concept more explicitly therefore does not constitute new matter.

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under 35 USC 112, second paragraph, hence placing claims 11-16 in prima facie condition for allowance

It is submitted that claims 1-16 are in compliance with 35 U.S.C. §§ 102, 103, and 12 each define patentable subject matter. A Notice of Allowance is therefore respectfully requested.

Enclosed is a check in the amount of \$120 for a one-month extension of time by a large entity, which applicant hereby requests. No other fees are believed to be payable with this communication. Nevertheless, should the Examiner consider any other fees to be payable in conjunction with this or any future communication, the Director is authorized to direct payment of such fees, or credit any overpayment to Deposit Account No. 50-1170.

The Examiner is invited to contact the undersigned by telephone if it would help expedite matters.

Respectfully submitted,

  
Timothy Newholm  
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Dated: December 21, 2004

Enclosure:

Declaration of Gregory J. Orzal

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